IN THE

Supreme Court of the United States

OCTOBER TERM, 1943

PAUL J. BELLAVANCE, Petitioner, v. FRANK MORROW CO., INC., Respondent.	No. 853

PETITION FOR REHEARING.

TO THE HONORABLE, THE CHIEF JUSTICE AND ASSOCIATE JUSTICES OF THE SUPREME COURT OF THE UNITED STATES

Statement.

This is a suit brought by petitioner against respondent for infringement of the claims of his two patents. The Circuit Court of Appeals for the First Circuit affirmed the judgment of the district court declaring the claims of the two patents in suit invalid. A petition for certiorari was filed April 6, 1944 and was denied May 15, 1944.

A rehearing is herewith petitioned for from the decision dismissing the petition for certiorari.

Grounds for Rehearing.

The First Circuit Court of Appeals in its opinion stated in its second Opinion in this case (Rec. p. 221):

p. 223 "we see no reason here to do more than advert again to the confusion in the law with respect to the nature of the question of patentable invention."

It must be that this Court overlooked this closing statement in the First Circuit Court's opinion that it finds the law as laid down by the U. S. Supreme Court is confused at present. Previously in said second Opinion the First Circuit Court explained why it found the law confusing, namely, because the U. S. Supreme Court has established two standards of invention.

In the Rules of the U. S. Supreme Court, No. 38, are given the reasons for granting a review on writ of certiorari, among which are

5 (b) "or has decided an important question of federal law which has not been, but should be, settled by this court;"

Certainly the standard of invention which determines the validity of a patent is an important question of federal law—one which ten Circuit Courts of Appeals and many more District Courts below them, are constantly dealing with. This question of federal law, namely, the standard of patentable invention, is unsettled, and the First Circuit Court said so in so many words. Obviously, it should be settled by this Court.

The reality of the present situation is this. The U. S. Supreme Court does and has set the standard of invention in the eyes of several Circuit Courts of Appeals and

District Courts below them. The first Circuit Court acknowledges this and follows the strict standard it interprets was set in the *Cuno Engineering Corp.* v. *Automatic Devices Corp.* case, 314 U.S. 84, 91, 92, and on page 219 of the Record it said:

> "It can be said that the Bellavance method is ingenious and a step forward in the art of making bracelets, but in view of the high standard of invention indicated by recent opinions of the Supreme Court (see *Cuno Engineering Corp.* v. *Automatic Devices Corp.*, 314 U.S. 84, 91, 92), we cannot believe that it is a sufficiently substantial step to warrant the grant of a patent."

Here is one Circuit Court that explicitly says that it follows the standard of invention of the U. S. Supreme Court set up in the *Cuno* case, *supra*. (See Rec. p. 223 also.)

The 2nd Circuit Court of Appeals has likewise adopted the standard of invention set up by the U. S. Supreme Court. See *Picard* v. *United Aircraft Corp.*, 128 F. 2d 632, 53 USPQ 563, wherein the 2nd Circuit Court said that the Supreme Court's word is final in setting the standard of invention. Other Circuit Courts also have adopted the standard of the U. S. Supreme Court; but not all.

On the other hand the 7th Circuit Court of Appeals does not recognize the standard of invention set up by the U. S. Supreme Court in the *Cuno* case, *supra*, and specifically said so in *Chicago Steel Foundry Co.* v. *Burnside Steel Foundry Co.*, 132 Fed. (2d) 812, 817. The standard of the 7th Circuit is obviously lower than in the First and Second Circuits, as is clearly apparent from its decision in *Ray-O-Vac Company* v. *The Goodyear Tire & Rubber Co.*, holding claims to a leakproof dry cell for batteries valid and infringed, which decision was affirmed

by the U. S. Supreme Court on February 28, 1944, 60 USPQ 386. Plaintiff-petitioner's method claims are clearly valid by the standard set in this *Ray-O-Vac* case.

In a decision released May 10, 1944 by the Court of Customs and Patent Appeals, 61 USPQ 362, 31 C. C. P. A. (Patents), that Court stated that it would not follow the "flash of genius" standard of invention set up in the *Cuno* case, *supra*, but would follow the long line of U. S. Supreme Court decisions that previously decided what the standard of patentable invention is. In discussing the *Cuno* case and its "flash of creative genius" term it said:

p. 367, USPQ:

> "While recognizing, of course, that it is the duty of this court to follow the law as declared by the Supreme Court, we do not conceive it to be our duty to change our basis of decision merely because some courts assume that there is a 'new doctrinal trend' with regard to the standards required for invention.
>
> "In our opinion it is not within the province of the courts to establish new standards by which invention is to be determined. It seems clear to us that the creation of new standards for the determination of what constitutes invention would be judicial legislation and not judicial interpretation."

But another appellate court that passes upon the patentability of inventions, which has concurrent jurisdiction with the Court of Customs and Patent Appeals on the question of the right of an inventor to be granted a patent, namely, the Court of Appeals, District of Columbia, in 60 USPQ 226, in the recent case of *Potis, et al.* v. *Coe,* decided that the law has been changed, and cited the *Cuno* case, *supra,* in support of its contention of said change.

Instances could be multiplied where courts that pass upon the validity of patents already issued, and upon the right of inventors to be granted patents, are taking opposite stands on the question of what constitutes patentable invention. This confusion resulted mostly from the *Cuno* case, *supra,* and its "flash of creative genius" term. It is a fact that the law of what constitutes patentable invention is, at present, uncertain and in confusion, and the statement by the First Circuit Court of Appeals in its second opinion in this case clearly described the situation as follows:

> Record p. 223. "The situation may be unfortunate in that it leads to the unequal application of the patent law—a relatively trifling contribution may eventually obtain the protection of a patent while a more important one may not, depending upon whether or not there is a conflict of view between circuits—but this is not a problem for us to cope with."

The "problem" is one for the U. S. Supreme Court to cope with, and the time to do it is now, since the instant case presents the opportunity, having been decided on its interpretation that the *Cuno* case, *supra,* set a new and higher standard of invention which the First Circuit Court follows (Rec. p. 223, 2nd opinion).

As the law now stands, in the 7th Circuit for instance, the standard of patentable invention is relatively low, and a patent such as the dry battery cell enclosed in a metal jacket is valid in that Circuit; but would not be in the First Circuit where the Court in its second opinion acknowledged that the method claims of the patent in suit covered an ingenious and successful invention. In other words the First Circuit Court accepts the standard of invention set up in *Cuno* v. *Automatic, supra,* and inventors lose patent rights to valuable inventions there,

while the Seventh Circuit Court does not accept said standard of the *Cuno* case, *supra*, with the result that inventors can successfully maintain their rights against infringers of their patents. Validity depends upon venue.

Obviously this is an unsettled situation which the U. S. Supreme Court should settle. While the *Cuno* case, *supra*, has not been cited in opinions of the U. S. Supreme Court for some time now; neither has it been overruled, and it has left every one guessing and groping and adopting various standards of inventions.

Consider the uncertainty thus created for the inventor who applies for a patent. If he appeals to the Court of Appeals for the District of Columbia, its standard is based on the *Cuno* case, *supra*, and its interpretation of the "flash of creative genius" term, and it is almost certain that he will be denied a patent for his invention. But if he appeals to the Court of Customs and Patent Appeals, his prospect of obtaining a patent are much better because that Court has specifically said that it will not acknowledge the *Cuno* case, *supra*, as setting forth a new standard of patentable invention, and that it will follow the old line of decisions.

The present chaotic situation cries out for settlement. The U. S. Supreme Court has the power and the duty to establish one standard of patentable invention throughout the United States, and it should act now, and the instant case is a most suitable vehicle to lay down the law since the First Circuit Court has definitely stated that it has followed to the best of its ability the "strict" standard, as it interprets it, in the *Cuno* v. *Automatic* case, *supra*, and will follow it until the "confusion in the law with respect to the nature of the question of patentable invention" is cleared up.

It is not the Courts alone that are confused. Articles endeavoring to interpret the *Cuno* case, *supra*, and later cases on what is the standard of patentable invention

are regularly appearing in the Journal of the Patent Office Society and in other publications. They show the greatest disagreement and uncertainty on this subject amongst members of the patent bar.

The petition for rehearing should be granted, and petition for certiorari allowed because of the great need to clear up the question of what constitutes patentable invention in the United States: which need the First Circuit Court of Appeals in the instant case has specifically pointed out.

Respectfully submitted,

HAROLD E. COLE,
Attorney for Plaintiff-Petitioner.

I hereby certify that the foregoing petition for rehearing is presented in good faith and not for delay.

HAROLD E. COLE,
Attorney for Plaintiff-Petitioner.